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March 11, 2005

To: Director TC 3600
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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/056,712 |
| | Filing Date | 1/28/2002 |
| | First Named Inventor | Perena |
| | Art Unit | 3611 |
| | Examiner Name | Luby |
| | Attorney Docket Number | PERE100 |
| Total Number of Pages in This Submission | | 7 |

| ENCLOSURES (Check all that apply) | | |
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| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
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MAR 11 2005

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Perena

PATENTS

Serial No. 10/056,712

Group Art Unit: 3611

Filed: 1/28/2002

Examiner: Luby

For: WALKING ASSISTANCE DEVICE

PETITION UNDER 37 CFR 1.181

Hon. Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

This is a petition under 37 CFR 1.181 to compel the Examiner to withdraw the outstanding rejection mailed November 3, 2004.

As will be seen from the following discussion, there are rejections by the Examiner which are improper because of procedural issues. Applicant has requested that these rejections be withdrawn, pointing out the reasons why the rejections are improper. The Examiner has refused to withdraw these rejections. This makes a petition under 37 CFR 181 timely.

The facts in this case are: the application has received a first rejection, a second rejection which was made final, and a response to a proposed amendment after the final rejection. The final rejection was appealed to the BPAI. The Board affirmed the Examiner as to claim 2 and reversed the Examiner as to claims 1 and 3-6. The Board suggested that the Examiner consider a new rejection of claim 1 and dependent claims 3-6 for obviousness based on 35 USC 103 based at least in part upon a combination of Mah with Jones along the lines presented in the rejection of claim 2.

Following the decision by the Board, the Examiner issued a new rejection on November 3, 2004, which rejection was in line with the suggestion of the Board.

Applicant filed a paper which was received by the Examiner on November 30, 2004 which requested the withdrawal of this rejection on the ground that the rejection was improper in that there is no provision for such action in the M.P.E.P. or the CFR. In making this request, applicant cited Section 1.198 of Title 37, which states:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

It was shown that Section 1.114 is not pertinent to the present situation.

It was stated that Section 41.50 describes the decisions and other actions which may be taken by the BPAI. This Section is divided into subsections (a)-(f).

Subsection (a) states that the BPAI may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. It was stated that this is what occurred in the present case. This Subsection also states that the Board may also remand an application to the examiner. This did not happen.

Applicant's request went on to show how Subsections (b) through (f) did not apply.

Subsection (a) does not give the Examiner authority to reopen prosecution. The reopening of prosecution by the Examiner is considered to be contrary to 37 CFR 1.198. The request went on to state that since the Examiner has reopened prosecution, since Sections 1.114 and 41.50 do not apply, and since there is no evidence that the Director

has given written approval, it appears that the Examiner has acted contrary to authority in reopening prosecution.

The Examiner responded to this request in an Office Action dated February 3, 2005. This Office Action repeated the rejections set forth in the Office Action dated November 4, 2004, the sole difference being that the Office Action bore the signature of the TC Director.

There was no discussion as to how the rejections were in compliance with 37 CFR 1.198. Avoiding this issue will not make this issue disappear.

The Office Action dated February 3, 2005 was responded to with a "request for withdrawal of rejection" dated February 7, 2005. This was not a response to the merits of the rejection. It did not purport to be such a response. This letter requested that the rejection be withdrawn as it was improperly made.

This letter pointed out that the M.P.E.P. makes provisions for all possibilities which may occur as a result of a decision by the Board of Patent Appeals and Interferences.

It was pointed out that Section 1214.06 of the M.P.E.P. is seen to be applicable to the present situation. This section deals with situations wherein the Examiner has been sustained in whole or in part, as is the situation in the present case. This Section covers five possibilities; I. no claims stand allowed, II. claims stand allowed, III claims require action, IV. 37 CFR 1.196(b) rejection, and V. appeal dismissed. Of these five possibilities, only Subsection II applies to the present situation. Subsection II states in part:

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. A red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

It was noted that the Examiner's options are limited to the activities set forth in Section 1212.06(II) of the M.P.E.P. There is no provision for re-opening of prosecution.

The Office Action dated March 8, 2005 held the above letter to be non-responsive to the Office action. This is correct. As noted above, the letter does not purport to be responsive to the Office Action. That letter was a request for withdrawal of the Office Action on the ground that the rejection was improper on formal grounds, that is, there is no basis in the statute, rules, or M.P.E.P. for making the rejection at this stage of the prosecution.

The Examiner takes the position that the present situation is governed by M.P.E.P. 1214.04. The Examiner is incorrect. This Section of the M.P.E.P. sets forth procedures to be followed when the Examiner is reversed as to all of the claims. Such is not the case in the present situation. Even if this Section of the M.P.E.P. governed the present situation, the Examiner would still be acting contrary to established Office policy. The above Section governs those situations in which the Examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the Examiner was reversed. The Examiner contends that he had knowledge of a particular reference since he had rejected claim 2 under it. According to the Examiner, it is now proper to apply that reference to claim 1. The Examiner had a first rejection, a final rejection, an advisory action, and an Examiner's Answer in which to apply that reference to claim 1. To wait until after a

decision by the Board to apply that reference to claim 1 goes contrary to the overarching principle of avoiding piecemeal examination. Note that M.P.E.P. 707.07(g) states that piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available.

The Examiner is of the opinion that Section 1214.06, Part II of the M.P.E.P. does not apply. This is so because that Section is effective only when claims stand allowed and, according to the Examiner, no claims have been indicated as allowable. The Examiner states that nowhere in the history of the prosecution has the Examiner ever indicated that claims are allowable. This is correct. However, once claims are passed on by the Board, this is not particularly relevant. The Examiner also urges that the Board has not indicated claims as being allowed. However, the Board reversed the Examiner as to claims 1 and 3-6 and did not enter a new ground of rejection under 37 CFR 1.196(b) as could have, and should have, been done had the Board considered that these claims were unpatentable. In view of this situation, it is considered that claims 1 and 3-6 stand allowed.

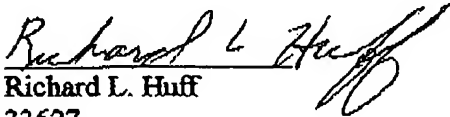
If it is assumed that the Examiner is correct in stating that at the end of the Board decision no claims stood allowed, then the examiner is guilty of not following the procedure outlined in Section 1214.06 (f) of the M.P.E.P. This Section states in part:

The proceedings in an application... are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files.

The Examiner stated that the submission Dated February 7, 2005 appears to be a *bona fide* attempt to provide a complete reply to the prior Office Action. As stated above, that letter was not an attempt to respond to the Office Action. No substantive issues are discussed regarding the rejections.

In view of the above, petition is made to the Director to compel the Examiner to follow the procedures clearly set forth in the M.P.E.P. and withdraw the rejections and pass the application to issue bearing allowed claims 1 and 3-6.

Respectfully submitted,


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